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The Commissioner of Patents

Attention: Jillian Allen

**BY FACSIMILE**

02 6283 7999

10 February 2006

Madam

**IN THE MATTER OF International Patent Application No. PCT/AU2004/001577  
in the name of COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH  
ORGANISATION  
entitled METHOD FOR MICROBE AND ENZYME DISCOVERY  
Our Ref: JSB:SP:FP20705**

We refer to the Written Opinion dated 23 January 2006 that issued on the above-referenced International patent application.

The Examiner has declined to provide any opinion on novelty, inventive step or industrial applicability based on the fact that she considers that the search was not directed to the types of metabolism indicators that claim 1 now specifies.

However, we point out that in essence, the metabolism indicators that are terminal electron acceptors are largely the metabolism indicators specified in original claim 7, with oxygen being a notable specific example. Oxygen as the metabolism indicator is the feature of several claims, and is the metabolism indicator relied upon in the examples. It is not unusual during International Preliminary Examination for claim 1 as originally filed to be broad, and for the applicant to make amendments to claim 1 based on the specification, and for the search conducted to contemplate this. Indeed, Articles 19 and 34 of the PCT specifically enable the applicant to do this, and the introduction of a limitation into claim 1 does not usually result in Examiners refusing to provide an opinion, especially when the applicant has provided several very comprehensive responses.

We understand that it would be difficult to provide an opinion if the set of claims is replaced with a completely new set of claims with different limitations, but in this case all of the original limitations of claim 1 remain, and the added limitation, that avoids the prior art cited by the Examiner, closely corresponds to the original limitation of a dependent claim 7

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(although the language used is different, to encompass those specific metabolism indicators in claim 7 and others like them). Moreover, the Examiner at the stage of preparing each Written Opinion made specific reference to the fact that she had recognised that metabolism indicators such as O<sub>2</sub>, as indicators of cellular activity, were clearly of importance to the applicant. As a particular example, in the second Written Opinion, the Examiner commented on the fact that the applicants had emphasised that the present invention is advantageous as it relies on the measurement of common metabolic indicators to determine the success of enrichment. Accordingly, the Examiner has had the materials before her to appreciate the core subject matter of interest to the applicants, although she disagreed that the claims as previously amended were sufficient to clearly limit the claims to this subject matter. Therefore, it appears rather unjust for the Examiner to now effectively void this examination procedure by providing no opinion, after the considerable expense, time and effort placed into the examination procedure by the applicant.

The fact that oxygen was the metabolism indicator used in the examples, and oxygen was discussed by the Examiner in the written opinions, suggests to us that the Examiner must have reviewed the search results looking for prior art showing the use of oxygen as the metabolism indicator, and given this could at least provide an opinion on this subject matter.

Accordingly, we ask the Examiner to reconsider her position that she can not provide an opinion on novelty, inventive step or industrial applicability, in view of the fact that there has been no change in the thrust of the present specification, and the examples showing the performance of the invention all focus on oxygen as the metabolism indicator, which is a specific example of a terminal electron acceptor. Failing this, we ask the Examiner to at least provide comments on the novelty, inventive step and industrial applicability of claims compared to the prior art searched (or located in the search), with a proviso or note to point out the subject matter she searched. We find that it is not uncommon for Examiners to issue Written Opinions indicating that the claims are novel and inventive, in the light of the documents located in the search, with the note that the search was limited to particular subject matter.

Favourable reconsideration is respectfully requested.

Yours faithfully  
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